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No. 01-423

Supreme Court, U.S.
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In The

Supreme Court of the United States

SEMITOOL, INC.,

Petitioner,

v.

NOVELLUS SYSTEMS, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITIONER'S REPLY MEMORANDUM

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PETITIONER'S REPLY MEMORANDUM

Respondent Novellus argues in its opposition brief that the Federal Circuit's "prosecution history estoppel" decision in this case was not governed by *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), *petition for cert. granted* (June 18, 2001) (No. 00-1543). Yet the Federal Circuit expressly described *Festo* as the basis for its decision, and nothing in the Federal Circuit's opinion describes any source for prosecution history estoppel other than the rule of *Festo*. This Court should not second guess the Federal Circuit as to whether there is some basis other than that explicitly relied upon by that court. The Federal Circuit can address that issue on remand if this Court narrows or reverses *Festo*.

The analysis of infringement by equivalents in this case is governed by the "complete bar" rule of *Festo*, so that a reversal of *Festo* will require a new evaluation of infringement pursuant to the doctrine of equivalents. This case should accordingly be held for resolution of *Festo*.

The decision of the Federal Circuit contained an analysis of infringement for each of the asserted patents. For each, the Federal Circuit provided an express statement that prosecution history estoppel was present for a single reason, a reason that relied upon the holding in *Festo*. Regarding the '310 patent, the Federal Circuit stated:

> When an amendment narrows the scope of a claim for a reason relating to patentability, no range of equivalents is available for that amended claim limitation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 569,

> 576, 56 USPQ2d 1865, 1872, 1878 (Fed. Cir. 2000) (en banc). Thus, because the "substantially enclosed" limitation was added for a reason relating to patentability, Semitool is barred by prosecution history estoppel from arguing that anything other than the head and the bowl can form a "seal" satisfying that limitation.

Petitioner's Appendix at 17. The Federal Circuit was equally explicit regarding the '708 patent:

> Semitool is similarly barred from obtaining any range of equivalents for the "substantially enclosed" limitation in the '708 patent. As indicated above, the prosecution history of the '310 patent is also relevant to the '708 patent, *see Elkay*, 192 F.3d at 981, 52 USPQ2d at 1115, and thus Semitool's addition of the "substantially enclosed" limitation during prosecution of the '310 patent for a reason relating to patentability precludes the application of the doctrine of equivalents to that same limitation in the '708 patent, *see Festo*, 234 F.3d at 569, 576, 56 USPQ2d at 1872, 1878.

Petitioner's Appendix at 17. In both instances, the Federal Circuit explicitly described this case as one invoking the rule of *Festo*. Moreover, the Federal Circuit referred only to prosecution history estoppel arising from an amendment. Contrary to Respondent's suggestions, the Federal Circuit never referred to "estoppel by argument."

Respondent's opposition is based upon a misreading of the Federal Circuit's decision. Respondent cites a portion of the Federal Circuit decision that does not discuss either prosecution history estoppel or "estoppel by argument." *See* Respondent's Brief at 5, n.7 & n.8 (citing

Petitioner's Appendix at 11). Instead, it discusses "claim construction," i.e., determining the meaning of the patent claims.

Under well-established patent law, "claim construction" involves an analysis that is separate from determining whether a prosecution history estoppel exists. "Claim construction" is the evaluation of the meaning of a claim. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). Once a claim has been construed, it is compared to the accused device to determine if the device infringes. *Id.* at 384. That second analysis – comparison of the claim to the accused product – involves a sequential evaluation, first of whether the accused product literally fits within the claim and second of whether the accused product is an equivalent of the claimed invention. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950). Prosecution history estoppel acts as a limitation on infringement pursuant to the doctrine of equivalents. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1996). Thus, an evaluation of a claim's meaning is entirely separate from an evaluation of whether prosecution history estoppel precludes infringement by equivalents.

Here, the Federal Circuit first evaluated the District Court's construction of the claims (Petitioner's Appendix at 11) and later evaluated prosecution history estoppel as part of the infringement analysis (Petitioner's Appendix at 17). When Respondent argued that the Federal Circuit found "prosecution history estoppel by argument," Respondent cited the Federal Circuit's claim construction

discussion, not the Federal Circuit's analysis of infringement. Respondent's Brief at 5 (citing Petitioner's Appendix at 11). Not surprisingly, the Federal Circuit's claim construction analysis never mentioned prosecution history estoppel, "by argument" or otherwise. That absence was for the simple reason that the claim construction process is separate from evaluating infringement and whether prosecution history estoppel applies. Respondent is wrong when it contends that a "prosecution history estoppel by argument" exists and forms a basis for the Federal Circuit's decision.

CONCLUSION

The Federal Circuit rejected infringement pursuant to the doctrine of equivalents because it applied the rule of *Festo*. Ultimate resolution of the infringement question in this case is therefore dependent upon the Court's ruling in *Festo*. This case should be held for resolution in accordance with the decision in *Festo*.

Respectfully submitted,

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